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Paul F. Manley

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EXAMINER

CORBIN, ARTHUR L

ART UNIT

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/784,707
Filing Date: February 23, 2004
Appellant(s): MANLEY, PAUL F.

MAILED
FEB 26 2007
GROUP 1700

Steven B. Leavitt
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 20, 2005, appealing from the Office action mailed February 17, 2005.

(1) Real Party in Interest

A statement identifying, by name, the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal agrees with the statement of the grounds of rejection included in the final office action. However, the Examiner erred in including MacPherson in that rejection statement. Also, in the grounds of rejection below, the rejection has been written to more clearly illustrate which references have been relied on in rejecting each claim.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

JP 55034966 A	Shigeo	3-1980
5,229,149	Cone	7-1993
6,376,000	Waters	4-2002
6,616,958	Stewart	9-2003

Nakanishi, Future and Present of Edible Film, Food Packag. (Jpn), no. 5, May 1989, pp. 73-82

Applicant's admission of the prior art

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-4, 7-19, 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakanishi, Food Packag. (Jpn), and Shigeo, JP 55034966 A, in view of Cone, U.S. Patent 5,229,149, Waters, U.S. Patent 6,376,000, and Applicant's admission of the prior art.

In regard to claim 1, Nakanishi discloses a method of decorating fruit with a design, comprising of selecting a fruit, selecting a design, printing the design, and attaching the design to the fruit (translation, page 17), as further evidenced by Shigeo (translation, page 2). Nakanishi does not expressly disclose the coating of the fruit with an edible coating. It was conventional in the art to provide coated fruit as evidenced by Cone (column 4, line 52) and the Applicant's admission of prior art. To modify Nakanishi and print on a conventional coated fruit, rather than a conventional uncoated

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fruit, would have been an obvious matter of choice since Nakanishi teaches the general process of printing on fruit and coating the fruit could increase consumer appeal and enhance taste. Also, it was well known in the art to attach designs to substantially water-intolerant substances, as evidenced by Waters (abstract). Since it was known to coat fruit with substantially water-intolerant substances as taught by Cone, and also to print on such substances as taught by Waters, it would have been obvious to print on coated fruit to add to the attractiveness of the product.

In regard to claim 2, Waters (at column 6, line 42) and the Applicant's admission of prior art both teach the use of an edible sheet for use in decorating chocolates. To extend this method to printing on coated fruit would have been obvious, in view of Nakanishi and Shigeo, in order to make the fruit more pleasing to the consumer's eye.

In regard to claim 3, it would have been expected by one skilled in the art that the color of the frosting sheet match the color of the coating. There is nothing in the claims suggesting the colors would be different.

In regard to claim 4, Waters (at column 6, line 49) and the Applicant's admission of the prior art disclose the use of an inkjet printer for printing designs onto edible sheets. To use this method to print designs for coated fruit would be obvious, in view of Nakanishi and Shigeo, to provide a quick way of printing and designs and an easy way to reproduce designs without changing the consistency of the coating.

In regard to claim 7, Waters (column 8, line 9) teaches the use of a backing (for edible paper) made of wax paper or plastic, which includes materials made from acetate. Therefore, it would have been obvious to choose acetate as the material for

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the backing of the film so that the backing would peel off easily while the edible film adhered to the fruit adding the art printed thereon.

In regard to claims 8-16, 21, and 22, the Applicant's admission of prior art discloses that it was well known in the field to use chocolate coatings and films. Edible films made of chocolate are commercially available and it is well known in the field that chocolate products can be made with different flavors. Using a film or coating made of caramel would have been obvious in order to provide another flavor and more options for the consumer. In addition, the prior art discloses that strawberries are commonly coated and decorated, and it would be obvious to extend this to other fruits for greater variety for the consumer.

In regard to claims 17 and 18, Nakanishi teaches that edible films can be attached to foodstuff by either moistening the film or using an adhesive (Table 5). As such, it would be obvious to attach a design to a fruit while the coating is still wet, and also, to use an adhesive in attaching, to achieve better adhesion between the design and the fruit.

In regard to claim 19, Waters (at column 6, line 42) and the Applicant's admission of prior art teach the selecting of a foodstuff, the selecting of a design to decorate a foodstuff, the printing of the design on an edible sheet, and the attaching of the edible sheet to foodstuff. It would be obvious to extend this method to fruit, in view of Nakanishi and Shigeo, in order to provide decorative fruit that would be pleasing to the consumer's eye.

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Claims 5, 6 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakanishi, Food Packag. (Jpn) and Shigeo, JP 55034966 A, in view of Cone, U.S. Patent 5,229,149, Waters, U.S. Patent 6,376,000, and the Applicant's admission of the prior art, as applied above, in further view Stewart, U.S. Patent 6,616,958.

In regard to claims 5 and 6, Stewart (at column 10, line 41) teaches the use of an edible film for decorating foodstuff. A design is printed on the film, which has a peelable backing. This use of an edible film would have been obvious to extend to the decoration of fruit, to make the fruit more pleasing to the eye. Also, the pre-printed design and peelable backing would make it easier to apply the design and further decorate the fruit.

In regard to claim 20, Stewart (at column 10, line 41) and the Applicant's admission of prior art teach the selecting of a foodstuff, the selecting of a design to decorate a foodstuff, the printing of the design on an edible film with a peelable backing, and the attaching of the edible film to foodstuff. It would be obvious to extend this method to fruit, in view of Nakanishi and Shigeo, in order to provide decorative fruit that would be pleasing to the consumer's eye.

(10) Response to Argument

Appellant argues that Nakanishi and Shigeo cannot be combined with Cone to achieve the claimed invention. However, claim 1 was rejected over these references in combination Waters and the appellant's admission of the prior art and the combined teachings of all of the references render the claimed invention obvious. Although the disclosures of Nakanishi and Shigeo relate to films for use on water-soluble foods, they

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provide the broad teaching of decorating fruit with edible film. Waters demonstrates that it was also well known in the art to attach designs to substantially water-intolerant substances. Since it was known to decorate fruit with edible films (as taught by Nakanishi and Shigeo), coat fruit with substantially water-intolerant substances (as taught by Cone), and print on such substantially water-intolerant substances (as taught by Waters), it follows that it would have been obvious to print on coated fruit to add to the attractiveness of the product.

Appellant argues, via a 132 affidavit submitted June 17, 2005 (referred to by appellant as "the attached affidavit"), that Waters discloses the use of molds, which have a constant shape and planar surfaces, and such methods would not work on the inconsistent shape and non-planar surfaces of fruit. However, the claims do not exclude the use of a mold and also do not specify a specific fruit or shape thereof. As such, the arguments are speculative and lack probative value. The examiner also notes that appellant's disclosure lists orange slices as a fruit that can be decorated by the claimed method (page 8 of the specification, line 3) and orange slices have planar surfaces.

Claims 2-22 depend from claim 1 and therefore, also remain rejected under 35 U.S.C. 103 for the reasons stated above.

Appellant's arguments concerning claim 4 are also unpersuasive. Appellant states "Ink cartridges filled with food coloring are known in the art and commercially available from Lucks Food Decorating Company..." on page 9 of the specification at line 2-4. Additionally, Waters discloses the use of an inkjet printer for printing designs onto

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edible sheets. Although Shigeo states that the use of inkjet printers has resulted in distortion, it has been established that the films of Shigeo are meant for water-soluble foods. It has been shown that it would be obvious to coat fruit with a substantially water-intolerant substance and then print on the coated fruit above. As such, one of ordinary skill in the art would look to the teaching of Waters for a method of printing, since Waters relates to decorative film for substantially water-intolerant substances, and therefore, would be led to the inkjet printing method, which provided a quick way of printing and designs and an easy way to reproduce designs without changing the consistency of the coating.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,


Arthur L. Corbin


February 21, 2007

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